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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,663	10/02/2000	William E. LeBoeuf	J-2961	3408

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 04/08/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/677,663

Applicant(s)

LEBOEUF ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 51-79 and 96-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 and 80-95 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **RESPONSE TO AMENDMENT**

### ***WITHDRAWN REJECTIONS***

1. The objections and 35 U.S.C. §112 rejections of record in paper #19, page 2, paragraphs 2 and 4 have been withdrawn due to Applicant's amendment in paper #20.
2. The 35 U.S.C. §102 rejection as anticipated by Kessler (4,116,426) of record in paper #19, page 3, paragraph 6 has been withdrawn due to Applicant's amendment in paper #20.
3. The 35 U.S.C. §102 rejection as anticipated by Miyake et al. (5,085,416) of record in paper #19, page 4, paragraph 7 has been withdrawn due to Applicant's amendment in paper #20.
4. The 35 U.S.C. §102 rejection of claims 39-41, 43, 46-49, 80-82, 86 and 87 *only* as anticipated by Alston et al. (5,270,089) of record in paper #19, page 5, paragraph 10 has been withdrawn due to Applicant's amendment in paper #20.
5. The 35 U.S.C. §102 rejection of claims 39-41, 43, 46-50, 80-82, 86 and 87 *only* as anticipated by Shigeru (10137140) of record in paper #19, pages 5-6, paragraph 11 has been withdrawn due to Applicant's amendment in paper #20.
6. The 35 U.S.C. §102 rejection as anticipated by Otten et al. (6,274,232 B1) of record in paper #19, page 6, paragraph 12 has been withdrawn due to Applicant's declaration under 37 CFR 1.131 in paper #20.
7. The 35 U.S.C. §102 rejection as anticipated by Carson et al. (6,383,614 B1) of record in paper #19, pages 6-7, paragraph 13 has been withdrawn due to Applicant's declaration under 37 CFR 1.131 in paper #20.

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8. The 35 U.S.C. §102/103 rejection of claims 44, 45, 84, and 85 *only* as anticipated by or over Alston et al. (5,270,089) of record in paper #19, pages 8-9, paragraph 16 has been withdrawn due to Applicant's amendment in paper #20.

9. The 35 U.S.C. §102/103 rejection of claims 44, 45, 84, and 85 *only* as anticipated by or over Shigeru (10137140) of record in paper #19, pages 9-10, paragraph 17 has been withdrawn due to Applicant's amendment in paper #20.

***REJECTIONS REPEATED***

10. The 35 U.S.C. §102 rejection of claims 80-83 and 86-87 as anticipated by Thompson (3,929,135) is repeated for reasons of record in paper #19, page 4, paragraph 8.

Thompson discloses an absorptive device comprising a topsheet with a plurality of holes, an absorbent core, and a backsheet. The topsheet and backsheet are made of polyethylene (thermoplastic material) and the absorbent core is made of creped cellulose wadding. See column 3, lines 19-42, column 6, lines 11-30, and figure 1.

11. The 35 U.S.C. §102 rejection of claims 1-5, 9-13, 25-30, 34-42, and 46-50 as anticipated by Vargo (4,328,275) is repeated for reasons of record in paper #19, pages 4-5, paragraph 9.

Vargo discloses a disposable floor mat comprising a top layer of discontinuous silicone-polyester, which is relatively rigid and substantially incompressible, an absorbent core of cellulosic fibrous material, and a liquid impervious layer made of polyethylene (thermoplastic material) or polyester (thermoplastic material) (col. 2, lines 17-52).

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12. The 35 U.S.C. §102 rejection of claims 1-4, 6, 9-16, 20-23, 25-29, 31, 34-37, 88-90, 94, and 95 **only** as anticipated by Alston et al. (5,270,089) is repeated for reasons of record in paper #19, page 5, paragraph 10.

Alston discloses a fluid absorbing system comprising a first layer of a grid of inverted cones with drain holes or openings, a fluid absorbing mat, and a liquid impervious bottom layer (figure 2). The absorbing mat comprises cellulose fiber (col. 3, lines 64-66).

13. The 35 U.S.C. §102 rejection of claims 1-4, 6, 9-16, 20-29, 31, 34-38, 88-90, 94, and 95 **only** as anticipated by Shigeru (10137140) is repeated for reasons of record in paper #19, pages 5-6, paragraph 11.

Shigeru discloses a handy paper chopping block comprising an upper layer of coated paper with holes, a pulp fiber absorbing center, and a polypropylene backing (European Abstract).

14. The 35 U.S.C. §102/103 rejection of claims 84 and 85 as anticipated by or over Thompson (3,929,135) is repeated for reasons of record in paper #19, pages 7-8, paragraph 15.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

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Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

15. The 35 U.S.C. §102/103 rejection of claims 7, 8, 18, 19, 32, 33, 92 and 93 **only** as anticipated by or over Alston et al. (5,270,089) is repeated for reasons of record in paper #19, pages 8-9, paragraph 16.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946,

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966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

16. The 35 U.S.C. §102/103 rejection of claims 7, 8, 18, 19, 32, 33, 92 and 93~~only~~ as anticipated by or over Shigeru (10137140) is repeated for reasons of record in paper #19, pages 9-10, paragraph 17.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

***NEW REJECTIONS***

**17. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

18. Claims 1-50 and 88-95 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 14, 25, 39 and 88 indefinite because they fail to set forth the composition or structure of the processing substrate and only claim properties of the such as “a cut-resistant surface”. Claims that merely set forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future. Ex parte Slob (PO BdApp) 157 USPQ 172.

The phrase “cut-resistant surface” in claims 1, 14, 25, 39 and 88 is unclear which renders the claims vague and indefinite. The only guidance from the specification for the cut-resistant surface is that it is preferably an apertured thermoplastic film capable of withstanding cutting by a serrated knife without substantial comprise of the sheet. This is relative to the amount of force used, the sharpness of the knife, etc. Given the fact that “cut-resistant” is a relative term, it is the examiner position that any layer will have some degree of “cut-resistance.” Therefore, since



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Applicant does not give a clear definition or the degree of “cut-resistant,” any layer will read on this limitation.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the cut-resistant surface to the barrier and the absorbent portion. It is unclear from the claim language if the cut-resistant surface is another layer, as applicant’s arguments seem to indicate, or if it is a surface of either the barrier or absorbent portion.

***Claim Rejections - 35 USC § 102***

19. Claims 1-5, 9-13, 25-30, 34-42 and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Coggins (5,520,945).

Coggins discloses a disposable sheet (single use processing substrate) used in food service applications to prevent the cross-contamination of foods and eliminate the need for time consuming clean-ups. The sheet has multiple uses such as for rolling dough, absorbing excess moisture, making sandwiches, cutting breads (cutting board) and condiments, and drawing excess oil away from fried items. See the abstract and column 1, lines 6-18 and column 3, line 51 to column 4, line 5.

The disposable sheet comprises a top layer (liquid-permeable/cut-resistant surface), a middle layer (liquid absorbent portion) and third/bottom layer (liquid impervious barrier) (col. 1, lines 54-60 and figure 1). The top layer can be provided from a variety of non-absorbent fabrics having a mesh of sufficient size to permit flour, moisture, or oil pass through the fabric. The top

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layer further comprises a non-woven material which may be constructed out of thermoplastic material such as polyester or polypropylene (col. 2, lines 21-34). The middle layer is an absorbent material such as a cellulose-type paper (col. 2, lines 38-39). The third/bottom layer is constructed of a thermoplastic material such as polyethylene which provides a barrier against liquid and organic food substances (col. 2, lines 9-14).

***Claim Rejections - 35 USC § 103***

20. Claims 6-8, 14-24, 31-33, 43-45 and 80-95 rejected under 35 U.S.C. 103(a) as being unpatentable over Coggins (5,520,945) in view of Brassington et al. (4,838,253).

Coggins discloses all the limitations of the instant claimed invention except for the top sheet being a continuous film having holes formed therein.

Brassington teaches an absorbent article where apertured plastic films may use interchangeably with non-woven meshes as the top liquid permeable layer. See column 4, lines 64-68, column 5, lines 57-65 and claim 1.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute an apertured plastic film for the liquid permeable non-woven mesh layer of Coggins because Brassington teaches apertured plastic and non-woven meshes are interchangeable. One of ordinary skill in the art would have been motivated to use an apertured plastic film, oppose to a non-woven mesh, because apertured film are cheaper and easier to manufacture.

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim,

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the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

21. Applicant's arguments regarding the objections and 35 U.S.C. §112 rejections of record have been carefully considered but are deemed moot since the rejections have been withdrawn.

22. Applicant's arguments regarding the 35 U.S.C. §102 rejections regarding the Kessler (4,116,426), Miyake et al. (5,085,416), Otten et al. (6,274,232 B1) and Carson et al. (6,383,614 B1) references of record have been carefully considered but are deemed moot since the rejections have been withdrawn.

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23. Applicant's arguments regarding the 35 U.S.C. §102 and §102/103 rejections regarding the Thompson (3,929,135), Vargo (4,328,275) and Alston et al. (5,270,089) references of record have been carefully considered but are deemed unpersuasive.

Applicant summarizes each independent claim with its dependents and argues "none of the cited references, alone or in combination, discloses or suggest a processing substrate having three distinct layers including a cut-resistant surface, a liquid impervious barrier, and a liquid absorbent portion adjacent the surface. Also, none of the cited references, alone or in combination, discloses or suggests such structure wherein the cut-resistant surface is thermoplastic." Applicant then summarizes the prior art of record without specifically pointing out which criteria of the claims is missing or why the features the examiner has pointed out in the rejections do not read on Applicant's invention. Applicant ends by arguing that "because none of the prior art discloses or suggest that it would be desirable or even possible to have a processing substrate having three distinct layers as specified by the claims at issue, it is evident that the claims, as amended, are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claims combination of elements in order for a *prima facie* case of obviousness to be established."

In response to Applicant's arguments, 37 CFR § 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references. Furthermore, 37 CFR § 1.111(c) requires Applicant to "clearly point out the patentable novelty which he or she thinks the claims

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present in view of the state of the art disclosed by references cited or the objections made.

Applicant must also show how the amendments avoid such references or objections.” In this case, Applicant has failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim. Therefore, the examiner maintains the 35 U.S.C. §102 rejections regarding the Thompson (3,929,135), Vargo (4,328,275) and Alston et al. (5,270,089) references, since Applicant has failed to show how the language of the claims specifically over comes each reference.

24. Applicant’s arguments regarding the 35 U.S.C. §102 and §102/103 rejections regarding the Shigeru (10137140) reference of record have been carefully considered but are deemed unpersuasive.

Applicant argues that Shigeru does not disclose a top layer that is cut-resistant or would be inherently cut resistant. Applicant’s attention is drawn to the 35 U.S.C. §112 rejection above regarding “cut-resistant.” Applicant further argues that the top layer of Shigeru is not thermoplastic. The limitation that the top layer is not all the claims. The examiner has withdrawn the rejections over Shigeru for all claims directed to the top layer being thermoplastic and maintained it for the ones that do not require a thermoplastic top layer.

### ***Conclusion***

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

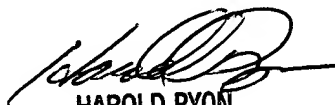
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If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

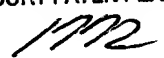
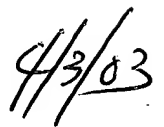
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

3/30/03

A handwritten signature in black ink, appearing to be 'AR' or similar, written over the date 3/30/03.A handwritten signature in black ink, appearing to be 'Harold Pyon', written above the printed name and title.

HAROLD PYON  
SUPERVISORY PATENT EXAMINER

Handwritten initials '1772' in black ink, located below the printed title.A handwritten date '4/3/03' in black ink, written to the right of the signature block.